REMARKS

Claims 1-10 are pending. Claims 11-20 are canceled without prejudice in view of the restriction requirement. The Examiner was absolutely correct that Applicant elected the species without traverse, and the issue should not have been raised again.

Claims 1-10 stand rejected. Applicant respectfully requests reconsideration of the reject based on the following comments.

Rejection Over Kaneda et al.

The Examiner rejected claims 1-3, 5, 7-10 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,638,662 to Kaneda et al. (Kaneda). Applicant incorporates by reference their arguments relating to Kaneda from the response of September 14, 2007 to simplify the present discussion and to focus on the Examiner's comments. Applicant strenuously maintains that Kaneda does not *prima facie* anticipate Applicant's claimed invention. Applicant respectfully requests reconsideration of the rejection based on the following comments.

As an initial matter, the Examiner stated that "applicants are asking the Examiner to invalidate the patent that has been issued by stating that the disclosure of 'nm' in column 6, line 59 is a typo and should be 'μm'." With all due respect, Applicant is not asking anything about the validity of Kaneda, nor is the validity of Kaneda relevant in any way with the issues before us. The claims of Kaneda have not been discussed, and a typo in a patent certainly does not invalidate a patent. The relevant issue is what Kaneda teaches and not the validity of Kaneda. See *In re Kumar*, 418 F.3d 1361, 1369 (Fed. Cir. 2005)("That is incorrect. To render a later invention unpatentable for obviousness, the prior art must enable a person of ordinary skill in the field to make and use the later invention. *Beckman Instruments, Inc.*, 892 F.2d at 1551; *Payne*,

606 F.2d at 314. Thus, the relevant inquiry is not whether the Rostoker patent was invalid for lack of enablement, but whether Rostoker enabled persons of skill in the art to produce particles of the size and distribution claimed by Kumar.")

To anticipate a claim, a reference must provide an enabling disclosure. See, MPEP 2131.01 I. "The proper test of a publication as a § 102(b) bar is 'whether one skilled in the art to which the invention pertains could take the description of the invention in the printed publication and combine it with his own knowledge of the particular art and from this combination be put in possession of the invention on which a patent is sought.' *LeGrice*, 301 F.2d at 939. In particular, one must be able to make the claimed invention without undue experimentation." *In re Elsner*, 381 F.3d 1125, 1128 (Fed. Cir. 2004). "Significantly, [this court has] stated that 'anticipation does not require actual performance of suggestion in a disclosure. Rather, anticipation only requires that those suggestions be enabled to one of skill in the art.'" *SRI Intern., Inc. v. Internet Sec. Systems. Inc.*, 5111 F3d. 1186, 1192 (Fed. Cir. 2008) quoting *Novo Nordisk Pharm., Inc. v. BioTechnology Gen. Corp.*, 424 F.3d 1347, 1355 (Fed. Cir. 2005) with an internal quote from *Brystol-Myers Squibb Co. v. Ben Venue Labs. Inc.*, 246 F. 3d 1368, 1379 (Fed. Cir. 2001).

Thus, the question is whether or not the typo in Kaneda raises Kaneda to an enabling reference. The examples do not teach powders with particles having the claimed average particle size. Applicant maintains that Kaneda does not teach an enabling method for producing the claimed particle collections. Since Kaneda does not provide an enabling disclosure of Applicant's claimed invention, Kaneda does not anticipate Applicant's claimed invention under well established law. "[A] § 102(b) reference "must sufficiently describe the claimed invention to have placed the public in possession of it." Paperless Accounting, Inc. v. Bay Area Rapid Transit Sys., 804 F.2d 659, 665 (Fed. Cir. 1986), cert. denied, 480 U.S. 933 (1987)(quoting In re Donohue,

766 F.2d at 533). The reference does not provide a reasonable expectation of success with respect to producing Applicants claimed compositions without undue experimentation, so it does not place Applicant's invention into the hands of the public.

Since Kaneda does not provide an enabling disclosure of Applicant's claimed invention, Applicant respectfully requests withdrawal of the rejection of claims 1-3, 5, 7-10 under 35 U.S.C. § 102(e) as being anticipated by Kaneda. While Applicant does not acquiesce with respect to issues relating specifically to the dependent claims, these issues are not specifically discussed since they are moot in view of the issue raised above.

Rejection of Claims 4 and 6

The Examiner rejected claims 4 and 6 as Kaneda as applied above and further in view of U.S. patent 6,534,216B to Narukawa et al. (Narukawa). The Examiner cites Narukawa for teaching substitutions of various metals for a portion of the cobalt in lithium cobalt oxides. However, Narukawa does not make up for the deficiencies of Kaneda with respect to the claimed invention. Applicant respectfully requests reconsideration of the rejection based on the following comments.

Narukawa does not make up for the deficiencies of Kaneda. In particular, see Fig. 6 of Narukawa. The average particle sizes range from about 7 microns to about 20 microns. The average particle sizes in Narukawa are almost two orders of magnitude larger than Applicant's claimed particle size, which has an upper limit of about 100 nanometers. The combined teachings of Kaneda and Narukawa do not enable practice of Applicant's claimed invention. Since the combined disclosures of Kaneda and Narukawa do not enable the production of Applicant's claimed particle collections, the combined teachings of Kaneda and Narukawa clearly do not render Applicant's claimed invention *prima facie* obvious.

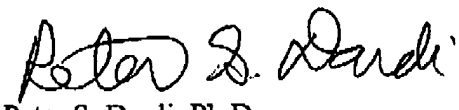
Since the combined teachings of Kaneda and Narukawa do not render Applicant's claimed invention *prima facia* obvious, Applicant respectfully requests withdrawal of the rejection of claims 4 and 6 as Kaneda as applied above and further in view of Narukawa. While Applicant does not acquiesce in the Examiner's assertions regarding the specific features of the dependent claims, these are not discussed further here due to the clear deficiencies with respect to the independent claim.

CONCLUSIONS

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



Peter S. Dardi, Ph.D.
Registration No. 39,650

Customer No. 62274
Dardi & Associates, PLLC
US Bank Plaza, Suite 2000
220 South 6th Street
Minneapolis, Minnesota 55402
Telephone: (404) 949-5730